

72e



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,948	04/30/2001	Tatsuo Itabashi	112857-222	3323
29175	7590	07/27/2005		
BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135				
			EXAMINER	
			KIM, JUNG W	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,948

Applicant(s)

ITABASHI, TATSUO

Examiner

Jung W. Kim

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7,8,10-12,14-20 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 and 22-27 is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7,8,10-12 and 14-197 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1, 3, 4, 7, 8, 10-12, 14-20 and 22-27 are pending.
2. Applicant in the amendment filed on May 13, 2005 and June 23, 2005 amended claims 1, 7, 14, 19, 20 and 25.
3. Claims 2, 5, 6, 9, 13, 21 and 28 are canceled.
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Continued Examination Under 37 CFR 1.114

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 23, 2005 has been entered.

Response to Amendment

6. The objection to claim 28 is withdrawn as the claim is canceled.
7. The 112, second paragraph rejection to claims 23 and 24 are withdrawn as the amendment to the claims in the amendment filed on May 13, 2005 overcomes the 112, second paragraph rejection.

Response to Arguments

8. Applicant's arguments filed June 23, 2005 have been fully considered.

Regarding amended claims 20 and 22-27, these arguments are persuasive, and hence, the rejections of these claims have been withdrawn; moreover, after further search and consideration, the invention defined in these claims have been found patentably distinct from the prior art. Regarding amended claims 1, 3, 4, 7, 8, 10-12 and 14-19, applicant's arguments are not persuasive. In particular, Applicant argues the cited prior art does not teach or suggest a data holding device communicatively coupled with a cellular telephone, and wherein information is communicated via a cellular telephone network (Remarks, pg. 18, 2nd full paragraph). Applicant alleges that the disclosure of Davis fails to anticipate this limitation although Davis expressly recites the use of a cellular device as a client terminal, since Davis does not disclose that communications between the client terminal and the merchant or payment server is made via a cellular telephone network but via the Internet. However, the use of a cellular telephone network is a necessary feature of any communications network wherein a cellular device communicates with a remote service connected to the Internet: information from a cell phone is transmitted over radio frequency to a cell and then switched to the relevant service (for example using a WAP gateway). Hence, the prior art of record cover the limitations of the claimed invention.

Claim Rejections - 35 USC § 102

9. Claims 14, 15 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Davis et al. U.S. Patent No. 6,282,522 (hereinafter Davis)

10. As per claim 14, Davis discloses an information providing system for performing predetermined processing using a data holding device capable of holding data including personal information for recognizing at least users, and a communication terminal device, the system comprising:

- a. a first information processing unit which, upon receiving transaction start information via a communication network, outputs a verification response confirmation request, performs predetermined processing based on the data of the data holding device upon receiving a response signal sent from the communication terminal device, and holds at least processing data, wherein the communications terminal device is a cellular telephone, and wherein the communication network is a cellular telephone network (Davis, figure 4, reference nos. 224 and 226 and related text; col. 12:7-11: the incorporation of a cellular telephone necessarily requires the use of a cellular telephone network); and
- b. a second information processing unit which, upon receiving the verification response request, confirms the communication terminal device corresponding to the identification information of the data holding device registered beforehand, calls up the communication terminal device via the communication network, and

upon receiving a response signal from the communication terminal device supplies the response signal to the first information processing unit (Davis, figure 5, reference no. 206 and 214, and related text).

The aforementioned cover the limitations of claim 14.

11. As per claim 15, the rejection of claim 14 under 35 U.S.C. 102(e) is incorporated herein. (supra) In addition, the first information processing unit receives identification information of the data holding device in addition to transaction start information, performs collation of the identification information, and in the event that positive results are obtained from the collation, outputs a certification response confirmation request to the second information processing unit. Davis, figure 7, reference no. 356. The aforementioned cover the limitations of claim 15.

12. As per claim 18, the rejection of claim 14 under 35 U.S.C. 102(e) is incorporated herein. (supra) In addition, the first information processing unit monitors and holds contents information of data of the data holding device, and upon receiving a contents information readout request provides the contents information held in the corresponding data holding device to the requesting party (Davis, figure 7, reference no. 234);

a. and wherein, upon receiving a contents information access request, the second information processing unit outputs a contents information readout request to the first information processing unit and requests the contents information of the data holding device, and transmits supplied contents

Art Unit: 2132

information to the communication network (Davis, figure 7, reference nos. 310, 312, 314a and 316a);

b. and wherein the communication terminal device further includes at least a display unit, with the contents information access request being transmitted by the communication unit thereof to the second information processing unit via the communication network, the contents information being displayed on the display unit upon the contents information of the data holding device transmitted from the first information processing unit having being received via the communication network (Davis, figure 7 and figure 10, reference nos. 512, 514 and 516).

The aforementioned cover the limitations of claim 18.

Claim Rejections - 35 USC § 103

13. Claims 1, 3, 4, 7, 8, 10-12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Walker et al. U.S. Patent No. 5,828,751 (hereinafter Walker).

14. As per claim 1, Davis discloses an information providing system comprising:

a. a communication terminal device, wherein the communication terminal device includes a display unit, a communication unit, and a transmitter, wherein the communications terminal device is a cellular telephone (Davis, figure 4, reference nos. 204 and 210, and related text; col. 12:7);

- b. a data holding device, communicatively coupled to the communication terminal device, wherein the data holding device stores content information and personal information pertaining to a user (Davis, figure 4, reference no. 5);
 - c. a first information processing unit for processing and storing contents information, and transmitting the contents information upon receiving a contents information readout request (Davis, figure 4, reference nos. 224 and 226); and
 - d. a second information processing unit for receiving contents information access requests sent from the communication terminal device via a communication network and outputting the contents information readout request to the first information processing unit so as to request supply of contents information of the data holding device, and transmitting the supplied contents information to the communication terminal device, wherein the communications network is a cellular telephone network (Davis, figure 4, reference nos. 206 and 214-216; figure 5, reference nos. 206 and 214; col. 12:7-11);
 - e. wherein the communication unit transmits, via the transmitter, the contents information access requests to the second information processing unit, and receives the contents information of the data holding device transmitted from the second information processing unit, such that received contents information is displayed on the display unit (Davis, 12:23-45).
15. Further, the communication terminal device transmits IC card identification information in addition to the contents information access request, and the second information processing unit collates received IC card identification information and pre-

Art Unit: 2132

registered identification information, and outputs the contents information readout request to the first information processing unit in the event that the received identification information and pre-registered identification information match. Davis, 17:27-51. However, Davis does not teach transmitting and verifying terminal identification information. Walker teaches transmitting and verifying terminal identification information to ensure the identity of the device handling a transaction. Walker, col. 4:38. It would be obvious to one of ordinary skill in the art at the time the invention was made to transmit and verify the terminal identification information in the system of Davis to uniquely secure the terminal device as taught by Walker. Ibid. The aforementioned cover the limitations of claim 1.

16. As per claim 3, the rejection of claim 1 under 35 U.S.C. 103(a) is incorporated herein. (supra) In addition, the system further comprises: a dedicated terminal device for performing exchange of data between the first information processing unit and the data holding device, wherein the first information processing unit performs predetermined processing based on the data holding device data, and updates the data held therein. Davis, col. 12:1-45. The aforementioned cover the limitations of claim 3.

17. As per claim 4, the rejection of claim 1 under 35 U.S.C. 103(a) is incorporated herein. (supra) In addition, the data holding device is an IC card. Davis, col. 10:66-11:47. The aforementioned cover the limitations of claim 4.

Art Unit: 2132

18. As per claims 7 and 8, the rejection of claim 3 under 35 U.S.C. 103(a) is incorporated herein. (supra) In addition, the method handles a plurality of data holding devices and data held in the multiple data holding devices are supplied to parties requesting access to the held data, wherein the personal data is processed to at least recognize individuals users associated with each data holding device. Davis, col. 6:18-26; figure 4, reference nos. 324, 236 and 235. The aforementioned cover the limitations of claims 7 and 8.

19. As per claim 10, the rejection of claim 7 under 35 U.S.C. 103(a) is incorporated herein. (supra) In addition, the supplied contents information is displayed on a predetermined terminal device. Davis, col. 7:11-12. The aforementioned cover the limitations of claim 10.

20. As per claim 11, the rejection of claim 7 under 35 U.S.C. 103(a) is incorporated herein. (supra) In addition, the method further comprises the steps of:

- f. performing settlement processing regarding settlement performed by the data holding device (Davis, figure 5, reference nos. 308, 314 and 318); and
- g. updating the contents information of data of the data holding device generated by the settlement processing, and transmitting to the data holding device (Davis, figure 5, reference no. 318).

The aforementioned cover the limitations of claim 11.

21. As per claim 12, the rejection of claim 11 under 35 U.S.C. 103(a) is incorporated herein. (supra) In addition, the updated information is displayed on the communication terminal device. Davis, figure 10, reference nos. 514 and 516. The aforementioned cover the limitations of claim 12.

22. As per claim 16, it is a claim covered by the teachings outlined in the claim 1 and 14 rejections, and it does not teach or define above the inventions outlined in the claim 1 and 14 rejections. Therefore, claim 16 is rejected as being unpatentable over Davis in view of Walker for the same reasons set forth in the rejections of claims 1 and 14.

23. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Nerlikar U.S. Patent No. 5,629,981 (hereinafter Nerliker).

24. As per claim 17, the rejection of claim 14 under 102(e) is incorporated herein. (supra) Davis does not disclose controlling output response signals based on position information of the communication terminal device. Nerliker teaches verifying a message from a device based on, inter alia, position information of the device, wherein the received position data from the device is compared to the expected position data, and if a match is found then the message is verified. Nerliker, figure 6; col. 9:40-50. It would be obvious to one of ordinary skill in the art at the time the invention was made to continue transaction processing when the location of a device is verified, since it is desirous to ensure that a requesting party of a transaction is verified to perform

Art Unit: 2132

transactions within authorized areas. Nerliker, 2:39-50. The aforementioned cover the limitations of claim 17.

25. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Claus.

26. As per claim 19, the rejections of claims 14, 15 and 18 under 35 U.S.C. 102(e) are incorporated herein. (supra) Davis does not disclose a second data holding device capable of holding data containing information that identify providers which provide at least products or services. Claus teaches transfer techniques using smart cards where a first data holding device is capable of holding personal information identifying at least users, and a second data holding device is capable of holding data containing information identifying providers which provide at least products or services. Claus, col. 2:44-57. It would be obvious to one of ordinary skill in the art at the time the invention was made for data holding devices to be utilized by both at least users and at least providers, since it is desirable to ensure the security and identity of both parties of a transaction as taught by Claus. Ibid. Hence, the invention covered by Davis in view of Claus covers the following:

- a. a first data holding device capable of holding data containing personal information identifying at least users (Claus, figure 1, reference nos. 102 and 107);

Art Unit: 2132

- b. a second data holding device capable of holding data containing information identifying providers which provide at least products or services (Claus, figure 1, reference nos. 104 and 105);
- c. a communication terminal device capable of performing data exchange between the first and second data holding devices and capable of communicating via a communication network, wherein the communication network is a cellular telephone network (Claus, figure 1, reference no. 106; Davis, 12:7-11); and
- d. an information processing unit which performs predetermined collation upon reception of data of the second data holding device transmitted from the communication terminal device, and upon obtaining positive collation results transmits a transaction processing continuation signal to the communication terminal device via the communication network, and then upon receiving the data of the first data holding device performs predetermined processing based on the received data, and holds at least processing data (Davis, figure 4, reference nos. 206, 214-216 and 238; figure 5, reference nos. 312, 314, 324 and 326; col. 14:18-25);

The aforementioned cover the limitations of claim 19.

Allowable Subject Matter

- 27. Claims 20 are 22-27 allowed.

Communications Inquiry

Art Unit: 2132

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W. Kim whose telephone number is 571-272-3804. The examiner can normally be reached on M-F 9:00-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



July 25, 2005

Jung W Kim
Examiner
Art Unit 2132


GILBERTO BARRON JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100